



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,858	06/15/2001	Kumiko Sugiyama	7217/64725	8536

7590 12/27/2004

JAY H. MAIOLI  
COOPER & DUNHAM LLP  
1185 Avenue of the Americas  
New York, NY 10036

EXAMINER

PEREZ, ANGELICA

ART UNIT PAPER NUMBER

2684

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/881,858

Applicant(s)

SUGIYAMA ET AL.

Examiner

Angelica M. Perez

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura (Kimura et al.; US Patent No. 6,539,243 B1) in view of Jarrad (Jarrad, Salah Khalil; US Patent No. 6,047,197 A).

Regarding claim 1, Kimura teaches of a portable telephone (figure 1, column 1, lines 5-7) for executing a plurality of functions (column 1, lines 40-53; columns 3 and 4, lines 62-67 and 1-7; where some examples of the functions are: "scroll button" function, "mail information processing function", "group search" function, etc.) selected from hierarchically structured menus (column 5, lines 63-67; column 7, lines 14-23 and column 1, lines 24-29 and 46-48; where the "predetermined order" and "main items" and "sub-items" represent "hierarchies"), the telephone comprising: a plurality of execution keys for instructing execution of respective functions from the plurality of functions (column 1, lines 40-43; e.g., "buttons" corresponding to "keys"; also columns 3 and 4, lines 62-67 and 1-27, respectively; e.g., "the user instructs the control section 32 to execute a mail information processing function by long-period pressing of the left scroll

button 10"...and execute group search processing by short-period pressing of the button...); function assigning means for assigning selected ones of the plurality of functions desired to respective ones of the plurality of execution keys (column 1, lines 43-46; column s 3 and 4, lines 62-67 and 1-27, respectively; claims 5 and 10; where broadly interpreted, the functions "scroll button", "mail information processing" or "search processing" can be assigned to the scroll button 10 depending on the amount of time the key is pressed); display means for displaying information (figure 1, item 4 and lines 4-12 of the abstract); and function executing means for executing the function assigned to the execution key in response to one of a pressing of the execution key (columns 3 and 4, lines 62-67 and 1-27, respectively; e.g., "the user instructs the control section 32 to execute a mail information processing function by long-period pressing of the left scroll button 10"...and execute group search processing by short-period pressing of the button...), where the plurality of execution keys is provided near the display means (lines 7-9 of the abstract and column 2, lines 40-42; e.g., "plurality of operation buttons arranged near the display screen"); and the display means displays a waiting screen showing short-cut icons representing the respective functions assigned to the execution keys by the function assigning means (figure 6, items 11, 13 and items in row 54; columns 3 and 4, lines 56-67 and 1-16, respectively), where the short-cut icons are shown on the waiting screen near the plurality of execution keys (figure 6, items 11, 13 and 54 are positioned near the plurality of execution keys 10, 12 and 14).

Kimura does not teach of a five-direction jog dial for movement in any of five directions, so as to perform input operations relative to the information displayed on the display means.

In related art concerning an icon driven phone menu system, Jarrad teaches of a five-direction jog dial for movement in any of five directions, so as to perform input operations relative to the information displayed on the display means (figure 1, item 14, column 2, lines 63-67 and column 3, lines 1-16; where the "five switches" have the same function described in the invention) (In addition, US publication no.: 2003/0117380 A1 attached as reference, paragraph 0017 refers item 3, in figure 1 as "jog dial" which compares to item 14 found in the Jarrad's art used in this rejection).

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Kimura's portable telephone for executing a plurality of functions with Jarrad's "five-direction jog dial" in order to facilitate the usage of the functions found in a portable telephone.

Regarding claim 3, Kimura teaches all the limitations according to claim 1. Kimura also teaches where the function assigning means assigns the function desired to the execution key regardless of a hierarchy of a menu containing the function (column s 3 and 4, lines 62-67 and 1-27, respectively; claims 5 and 10; where broadly interpreted, the functions "scroll button", "mail information processing" or "search processing" can be assigned to the scroll button 10 depending on the amount of time the key is pressed. In addition, the assignments are done without considering the

Art Unit: 2684

hierarchy of the menu. Column 8, lines 1-23; e.g., where the functions "register" and "insert" can be "arbitrarily set" corresponding to disregard hierarchy of the menu).


**Conclusion**

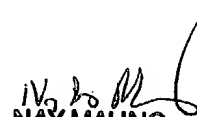
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angelica Perez whose telephone number is 703-305-8724. The examiner can normally be reached on 7:15 a.m. - 3:55 p.m., Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and for After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either the PAIR or Public PAIR. Status information for unpublished applications is available through the Private PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2600's customer service number is 703-306-0377.

  
Angelica Perez  
(Examiner)

  
NAY MAUNG  
SUPERVISORY PATENT EXAMINER  
Nay A. Maung  
(SPE)

Application/Control Number: 09/881,858

Page 7

Art Unit: 2684

(Examiner)

(SPE)

Art Unit 2684

December 16, 2004